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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/523,696

08/02/2005

Gerhard Schinzel-Reiner

2732-160

8531

6449

7590

12/31/2007

ROTHWELL, FIGG, ERNST & MANBECK, P.C.

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WASHINGTON, DC 20005

EXAMINER

CICCHINO, PATRICK D

ART UNIT

PAPER NUMBER

4114

NOTIFICATION DATE

DELIVERY MODE

12/31/2007

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTO-PAT-Email@rfem.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/523,696	<b>Applicant(s)</b> SCHINZEL-REINER ET AL.	
	<b>Examiner</b> PATRICK D. CICCHINO	<b>Art Unit</b> 4114	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 February 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 February 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2/3/2005 and 8/2/2005</u> .                                   | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. In response to the Preliminary Amendment filed on February 3, 2005, claims 1-14 are pending.

#### ***Drawings***

2. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because neither informal or formal drawings has been received. It is noted that the only drawings was cited in the World Patent No. WO 2004/014768 A1. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

#### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 10-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 10, the phrase “and/or” (in regards to claims 1, 11, 12, and 13) renders the claim indefinite because it’s an alternate expression and it’s subject to more than one interpretation.

Art Unit: 4114

Regarding claims 12-14, the preamble therein is misdescriptive, because these claims are depended on the method claim, i.e. claim 1, however, the claimed limitations in claims 12-14 are directed to structural elements of the apparatus.

Claim 11 is rejected for incorporating the above error from it's respective parent claim by dependency.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 3-7 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Gerlier (US Pat. No. 5,140,166).

Regarding claim 1, Gerlier teaches the use of detecting the alignment of a sheet transported separately, checking the detected alignment and aligning the to the desired alignment in a direction deviating from the transport direction wherein detection of sheet alignment is performed while the sheet is being aligned as well as after the sheet is aligned, while after the sheet is aligned, the aligning is terminated (as shown in figures 2-4 and column 4, lines 30-39 and column 5, lines 51-66).

Regarding claim 3, Gerlier teaches the use of a device for detecting the alignment (29) of a sheet transported separately, checking (29, 16) the detected alignment and aligning the to the desired alignment in a direction deviating from the transport direction wherein detection of sheet

Art Unit: 4114

alignment (29) is performed while the sheet is being aligned and the aligning sensors are directly next to the means for aligning and after the sheet is aligned, the aligning is terminated by use of a brake as well as a alignment lifting device (as shown in figures 2-4 and column 4, lines 30-39 and column 5, lines 51-66).

Regarding claim 4, Gerlier discloses the light sensors detecting in a 2D manner (as shown in figure 6).

Regarding claim 5 and 6, Gerlier teaches the use of rollers in conjunction with conveyor belts (as shown in figure 4) as well as the use of rollers (regarding claim 6 and as shown in figure 1) which both mechanically act as a means for aligning (regarding claim 5).

Regarding claim 7, Gerlier teaches a means for lifting the conveyor belts and rollers for aligning (as shown in figure 4, and column 5, lines 51-66).

Regarding claim 13, as best understood, Gerlier reveals a counting system as being part of the control device (as shown in figure 1 and 2, and column 4, lines 3-14).

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

Art Unit: 4114

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 2, 10, 11 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gerlier (US Pat. No. 5,140,166) in view of Ek (US Pat. No. 5,755,437).

Regarding claims 2 and 10, it is noted that Gerlier doesn't teach the use of a transport system wherein the transport is slowed or stopped in accordance with distance from the previous or next sheet or bank note. However, Ek discloses the use of slowing, stopping and even reversing the direction of feed if a bank note is received prematurely or sped up if the bank note is received too late (as shown in column 4, lines 28-56). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the Gerlier reference with the teachings of Ek to use a system for making sure a bank note was properly spaced from the previous or next with the motivation or make sure timely and accurate aligning is taking place.

Art Unit: 4114

Regarding claim 11, Ek teaches the slowing and reversing of the bank note to be done by mechanical means (as shown in figure 3 and 4).

Regarding claim 14, as best understood, Ek teaches the alignment of bank note with the means for checking a bank note while Gerlier teaches the counting of sheets.

9. Claims 8, 9 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gerlier (US Pat. No. 5,140,166) in view of Craft (US Pat. No. 3,918,706).

Regarding claim 8, it is noted that Gerlier doesn't teach the use of a non-contacting form to align bank notes. However, Craft reveals the use of a pneumatic device in order to align sheets which act in a non-contacting fashion (as shown in figure 1 and the abstract). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the Gerlier reference with the teachings of Craft in order to make a non-contacting alignment device with the motivation to check a sheet for misalignment before and after the aligning process.

Regarding claim 9, Craft et al discloses the use of an airflow that will transport the sheet in a direction deviating in the direction of transport (as shown in figure 1).

Regarding claim 12, as best understood, Craft discloses the use of a guiding member (14) so that the sheet has something to abut against in the aligning process which is aligned (as shown in figure 1).

***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to PATRICK D. CICCHINO whose telephone number is (571)270-1954. The examiner can normally be reached on Monday-Friday, 8:00-5:30 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joe H. Cheng can be reached on (571) 272-4433. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/P. D. C./  
Examiner, Art Unit 4114  
12/13/2007

/Joe H Cheng/  
Supervisory Patent Examiner  
Art Unit 4114